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10/750,710	01/02/2004	Stephen P. DeLisle	9438-2	4095
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/750,710
Filing Date: January 02, 2004
Appellant(s): DELISLE ET AL.

MAILED
MAR 17 2006
Group 3700

James Cannon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 8, 2006 appealing from the Office action mailed July 5 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

1,645,001	HODGES	10-1927
2,455,705	SEAGER	12-1948
2,693,358	DAWSON, JR.	11-1954

6,710,135	TAN ET AL.	03-2004
1,644,979	CLAUSING	10-1927

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 8-10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Clausing (1,644,979). Regarding claim 1, Hodges discloses a golf tee comprising an elongate shaft (10) and a support cup (11). The support cup has a discontinuous annulus (note Figure 2) defining three arcuate support prongs (15). Note Figure 1 showing a concave upper surface for the base portion.

Clausing discloses a golf tee including a concave support surface (8) that does not contact a golf ball (note Figure 3). It would have been obvious to one of ordinary skill in the art to form the golf tee of Hodges with a radius of curvature for the support surface such that the golf ball only contacts the prongs in order to minimize the resistance to the golf ball at the moment of departure from the tee.

Regarding claim 2, the prongs (15) of Hodges appear to be of a secant length that is greater than a dimple of a conventional golf ball. In the alternative, even though Hodges does not disclose for his dimples to not fit within the dimples of a golf ball, it would have been obvious to one of ordinary skill in the art to form the prongs of a length greater than a golf ball dimple in order to firmly support a golf ball.

Regarding claims 3, 4 and 10, the recited secant length and taper angle are considered to be obvious given the teachings of Hodges and the lack of a teaching for the claimed dimensions'

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criticality by the demonstration of a new and unexpected result obtained therefrom. Regarding claim 8, Hodges includes flutes (18) in the shaft.

Regarding claim 9, note Figure 1 showing the shaft decreasing in diameter along the length.

Regarding claims 12 and 13, Hodges discloses for his tee to be formed from a biodegradable material.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Clausing (1,644,979) and Dawson, Jr. (2,693,358). Regarding claim 5, Hodges lacks the teaching for support prongs to comprise a convex contact surface with the golf ball.

Dawson, Jr. reveals a golf tee construction including a contact surface for a golf ball. Note Figures 2 and 3a showing a non-convex contact surface (5) and a convex contact surface (15). Note also column 2, lines 52-54 stating that the convex contact surface provides a better seat for a golf ball. Thus, it would have been obvious to one of ordinary skill in the art to form the prongs of Hodges with a convex contact surface in order to better support a teed golf ball.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Clausing (1,644,979) and Seager (2,455,705). Seager discloses a golf tee construction including a plurality of prongs that support a golf ball. Note Figures 1 and 3 showing that both three and four configurations are known in the art. It would have been obvious to one of ordinary skill in the art to form the golf tee of Hodges with four prongs as Seager teaches that golf tees with three or four prongs are considered to be equivalents in the art

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and one of ordinary skill in the art would have found it obvious to substitute four prongs for three prongs in the golf tee.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Clausing (1,644,979) and Tan (6,710,135). Tan discloses a biodegradable golf tee construction including a polylactic acid. It would have been obvious to one of ordinary skill in the art to form the tee of Hodges with a polylactic acid for the reasons advanced by Tan.

Claims 15-19, 22-27, 29-33, 36-40, 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Dawson, Jr. (2,693,358). Regarding claims 15 and 29, note the rejections of claims 1, 2 and 5 above.

Regarding claims 16, 17, 23, 24, 30, 31, 37 and 38, note the rejection of claims 3, 4, 9 and 10.

Regarding claims 18, 19, 32 and 33, the recited radii of curvature for the contact surfaces is considered to be obvious given the teachings of Hodges in view of Dawson, Jr. and the lack of a teaching for the claimed dimensions' criticality by the demonstration of a new and unexpected result obtained therefrom.

Regarding claims 22 and 36, note the rejection of claim 8.

Regarding claims 25, 26, 39 and 40, note the rejections of claims 12 and 13.

Regarding claims 27 and 42, note the rejection of claim 1.

Regarding claim 43, note the rejections of claims 1, 2 and 5. Further, the recited dimension for the contact area between the contact surfaces and the golf ball resting on the contact surfaces is considered to be obvious given the teachings of Hodges in view of Dawson

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and the lack of a demonstration for the criticality of the claimed dimension by a new and unexpected result obtained therefrom.

Claims 20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Dawson, Jr. (2,693,358) and Seager (2,455,705). Note the rejection of claim 6.

Claims 21 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Dawson, Jr. (2,693,358) and Clausing (1,644,979). Note the rejection of claim 1.

Claim 28 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hodges (1,645,001) in view of Dawson, Jr. (2,693,358) and Tan (6,710,135). Note the rejection of claim 14.

(10) Response to Argument

A. Introduction

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

B. Rejections under Section 103(a) of Independent Claim 1 and Claims Dependent Therefrom

The appellant contends that the teachings of Hodges and Clausing are not properly combinable because Hodges particularly teaches for the ball to be “securely seated” and that the “edge portions” of the “spaced sections” fit into the dimples or recesses in the ball. The appellant further states that this teaching is in direct contrast to the desired result of the tee of instant claim 1.

However, these arguments should not be persuasive because, while Hodges suggests an interengagement between the prongs and the dimples of the ball, he neither states nor implies that the upper surface of the base portion need contact and support the tee. Further, attention is directed to Figure 3 of Clausing showing a pronged golf tee wherein the prongs (7) engage the dimples or surface of the ball and the upper surface of the base portion (9) does not contact the surface of the ball. Moreover, Clausing provides a suggestion to modify the reference to Hodges by stating that the elimination of this contact with the golf ball will minimize resistance to the flight of the ball (page 1, lines 47-50 and 61-65). Clearly, this advantage would be beneficial to a golfer using the tee of Hodges.

Further, the appellant’s argument that the teachings of Hodges are in direct contrast to those of instant claim 1 is without merit. Nowhere in claim 1 is any “desired result” recited that is contrary to the teachings of Hodges. Instant claim 1 merely defines a discontinuous annulus defined by three arcuate support prongs projecting upwardly from a base portion. The radius of curvature of the upper surface is less than 0.6 inch such that a golf ball resting on the prongs does not contact the base portion upper surface. Hodges teaches the discontinuous annulus defined by three arcuate support prongs projecting upwardly from a base portion of a tee. The reference to Clausing teaches that it is well known in the art of golf tees to have a golf ball not be supported

by the entire upper surface of the golf tee and instead supported by prongs extending from the tee. Clausen provides a suggestion to modify by stating that having the golf ball not rest on the upper surface of the tee minimizes the resistance to flight of the ball.

C. Rejections Under Section 103(a) of Independent Claims 15, 29 and 43 and Claims Dependent Therefrom

The appellant contends that the teachings of Hodges and Dawson are not combinable because the prongs of Hodges fit into the dimples or recess of the golf ball and by providing convex surfaces on the prongs would destroy this intent.

However, this argument should not be persuasive because, while Hodges states that the prongs and the dimples of a golf ball may engage one another, the appellant has not provided any definitive evidence that providing the prongs with the convex surface of Dawson would destroy Hodges intent. Indeed, the appellant states that the inclusion of convex surfaces on support prongs *can* reduce the amount of contact area. Clearly, this statement falls far short of a convincing rationale that the teachings of Dawson would destroy the intent of Hodges. Further, attention is drawn to column 2, lines 56-59 of Dawson stating that the convex surfaces provide a better seat for the golf ball. Clearly this teaching goes hand in hand with the intent of Hodges and thus, given the teachings of both Hodges and Dawson, one of ordinary skill in the art would be led to the invention recited in the instant claims.

The appellant also argues that it is not entirely clear from Figure 3a of Dawson that the ball would actually rest on the bead. However, this argument should also not be persuasive as Dawson clearly states that the bead (15) provides a better seat for a golf ball and serves as a stop to limit downward movement (column 2, lines 52-59). If the bead (15) provides a better seat for

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the golf ball, then clearly, the ball rests upon the bead. Further, the instant claims only state that the prongs present a convex contact surface for contacting a golf ball. Even if the seated ball rests on the upper edges of the tube (12) as appellant argues, the limitations of the claim are still met by the combination as convex contact surfaces are still presented that are obviously capable of contacting a golf ball.

In response to appellant's argument that the combination of Hodges in view of Dawson does not teach the inclusion of convex contact surfaces for the same reasons as recited in claims 15, 29 and 43, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

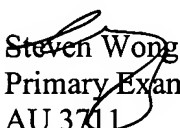
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(11) Related Proceeding(s) Appendix


No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Steven Wong
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AU 3711

Conferees:

Raleigh Chiu


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